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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,883	11/21/2000	Susana Salceda	DEX-0115	2018

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EXAMINER

YU, MISOOK

ART UNIT	PAPER NUMBER
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1642

18

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/717,883

Applicant(s)

SALCEDA ET AL.

Examiner

MISOOK YU, Ph.D.

Art Unit

1642

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 January 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 3-7.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Continuation of 5. does NOT place the application in condition for allowance because: the claims are rejected for failing to set metes and bounds of applicant's invention by citing a polynucleotide hybridizes under stringent conditions without defining "stringent conditions" in the specification. Applicant argues that stringent conditions are well known in the art and further argues that it means the percentage of matching nucleotides be 70 % or greater for stringent hybridization to occur. These arguments are convincing because applicants argues with limitations not specified in the instant claims and what could be hybridized depends on hybridizing conditions and what are stringent hybridizing conditions could be subjected to different interpretation. The specification does not define 70 % or greater sequence identity to SEQ ID NO:1 is stringent conditions. Further, it is not clear if a polynucleotide with 69.99 % match to SEQ ID NO:1 would not be hybridized to SEQ ID NO:1 under "stringent conditions" while one with 70 % matching is hybridized to SEQ ID NO:1 under the same conditions.

The claims are also rejected for failing to provide written description of the instant claims reciting a polynucleotide which hybridizes under stringent conditions. Applicant argues that the instant specification clearly provides the required definitive structural features that the claimed polynucleotides have at least 70 % identity to SEQ ID NO so that one of skill in the art can predictably identify molecules as being encompassed by the claims. These arguments are not convincing because applicant argues with limitation not specified in the claims. Further, the specification does not provide written descriptions for structural features of polynucleotides which hybridizes under stringent conditions.

Further, claim 7 is still pending and the claims also recites "a polynucleotide which hybridizes under stringent conditions in lines 3-4 in step (b). Therefore claim 7 is also rejected. Applicant does not argue about status of claim 7 in the response filed on 1/22/2003. .